FILED
MAY 26 1981
ALEXANDER L. STEVAS
CLERK

NO. 80-1869

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1980

INTERNATIONAL ORDER OF JOB'S DAUGHTERS
Petitioner,

vs.

LINDEBURG AND COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION

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Respondent respectfully opposes granting of the Petition for Certiorari for reasons set forth hereinafter.

I

SUMMARY OF ISSUES RAISED

None of the "QUESTIONS PRESENTED" on page (i) of the Petition merit this Court's review.

The First question, whether the name or emblem of a fraternal organization can *ever* serve as a trademark, is

not in issue—the Ninth Circuit expressly acknowledged that such emblems could serve as trademarks, but found that in this case the Job's Daughters emblem did not.

The Second question, whether the Ninth Circuit correctly rejected the *Boston Hockey* reasoning that a purely functional use of an emblem violates the Lanham Act, is fallacious because *Boston Hockey* is not based on any such "reasoning".[1] Further, the rejection by the Ninth Circuit of certain specific language in the *Boston Hockey* decision, does not create a conflict between the Ninth and Fifth Circuits.

The Third question, whether the sale of merchandise bearing Petitioner's emblem violates the purportedly exclusive rights of Petitioner, requests this Court to decide the correctness of the trial court Findings as well as the correctness of the Ninth Circuit's conclusions applying universally followed principles of trademark law to said Findings.

II

THE NINTH CIRCUIT DID NOT DECIDE THAT A FRATERNAL EMBLEM COULD NEVER FUNCTION AS A TRADEMARK

Petitioner's brief erroneously characterizes the Ninth Circuit Opinion as excluding fraternal emblems from ever being regarded as trademarks and protectable as such. The Opinion of the Court states clearly that such an emblem

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[1]See *Kentucky Fried Chicken v. Diversified Packaging Corp.*, 549 F.2d 368 (5th Cir. 1977), discussed infra.

could function as a trademark, but under the facts as found by the trial court, the Job's Daughters emblem did not so function as a trademark:

> "Our holding does not mean that a name or emblem could not serve simultaneously as a functional component of a product and a trademark. [cit.] That is, even if the Job's Daughters name and emblem, when inscribed in Lindeburg's jewelry, served primarily a functional purpose, it is possible that they could serve secondarily as trademarks if the typical customer not only purchased the jewelry for its intrinsic functional use and aestheic appeal but also inferred from the insignia that the jewelry was produced, sponsored, or endorsed by Job's Daughters." (Opinion, p. 10)

III

THERE IS NO CONFLICT BETWEEN THE FIFTH AND NINTH CIRCUIT LAW ON THE SUBJECT OF PROTECTABLE TRADEMARKS

Respondent disagrees that there is any conflict whatsoever between the legal test that would be applied to the facts of this case by the Fifth or the Ninth Circuit or any other Circuit. Rather, the only difference between cases in the respective Circuits is their outcome, dependent necessarily on the peculiar facts of each case. See *Cohens v. Commonwealth of Virginia* (1821) 19 U.S. 264, 399-400; 6 Wheat 264; 5 L.Ed 257, 290.

> "It is a maxim, not to be disregarded, that general expressions, in every opinion, are to be taken in connection with the case in which those expressions are used. If they go beyond the case, they may be

> respected, but ought not to control the judgment in a subsequent suit, when the very point is presented for decision. The reason of this maxim is obvious. The question actually before the court is investigated with care and considered in its full extent. Other principles which may serve to illustrate it are considered in their relation to the case decided, but their possible bearing in all other cases is seldom completely investigated."

There is no difference whatsoever between applicable law applied to cases of this type by the various Circuits.

In *Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975) *cert. denied*, 423 U.S. 868, the Fifth Circuit found that purchasers would likely be confused as to the origin or sponsorship of merchandise sold bearing the emblems of various hockey teams. Here, the Ninth Circuit found that purchasers would *not* be confused as to the origin or sponsorship of merchandise bearing the Job's Daughters emblem. The legal test for trademark infringement is the same in both cases, namely, whether a "likelihood of confusion" exists as to origin or sponsorship. This is the statutory test of Section 43(a) of the Lanham Act [15 U.S.C. 1125(a)].

It is true that the Ninth Circuit did reject certain specific language contained in the *Boston Hockey* decision, refusing to interpret that decision as a broad extension of trademark principles. However, as noted by the Ninth Circuit in Footnote 10 of the *Job's Daughters* Opinion, any

such broad reading of the *Boston Hockey* decision had already been rejected by the Fifth Circuit in its subsequent decision in *Kentucky Fried Chicken v. Diversified Packaging Corp.*, 549 F.2d 368 (5th Cir. 1977). In *Kentucky Fried Chicken* the Fifth Circuit explained its earlier *Boston Hockey* decision as follows:

> "Trademark infringement occurs only when the use sought to be enjoined is likely to confuse purchasers with respect to such things as the product's source, its endorsement by the plaintiff, or its connection with the plaintiff [citations omitted]. Our cases demonstrate unbroken insistence upon likelihood of confusion, and by doing so they reject any notion that a trademark is an owner's 'property' to be protected irrespective of its role in the operation of our markets. [citation omitted]
>
> These principles were not altered by our recent decision in *Boston Professional Hockey Association, Inc., v. Dallas Cap & Emblem Manufacturing, Inc.*, 510 F.2d 1004 (5th Cir. 1975), cert. denied, 423 U.S. 868, 96 S.Ct. 132, 46 L.Ed 2d 98 (1975). Acknowledging that the confusion question there was *conceptually difficult*, we found the confusion requirement satisfied by the '*certain knowledge* of the buyer that the *source and origin of the trademark symbols* were in Boston Hockey.' 510 F.2d at 1012 (certain emphasis added).
>
> In the case at bar the buyers undoubtedly possess certain knowledge that the source and origin 'of the trademark symbols' is in Kentucky Fried. By emphasizing this one phrase from our comprehensive opinion, *Boston Hockey* could therefore be read to dispose of the confusion issue here.

> We decline, however, to adopt that reading. *Boston Hockey* also reiterated our unbroken insistence on a showing of confusion, and we believe that our opinion must be read in that context." 549 F.2d 368, 388-389.

In deciding the case at bar, the Ninth Circuit, (like the Fifth Circuit in *Kentucky Fried Chicken, supra*) determined that there was *no* confusion or likelihood of confusion as to origin or sponsorship:

> "We conclude that Job's Daughters did not meet its burden of proving that a typical buyer of Lindeburg's merchandise would think that the jewelry was produced, sponsored, or endorsed by the organization. (Opinion p. 12)

Therefore, if asked to decide this case on its particular facts, the Fifth Circuit would apply the exact same legal test and thereby reach the same result as the Ninth Circuit —i.e., lack of likelihood of confusion as to source or sponsorship.

IV

THIS CASE DOES NOT MERIT A FACT REVIEW BY THIS COURT

Petitioner requests, in effect, that this Court review the undisputed facts of this case, and reach an independent judgment as to whether the Ninth Circuit correctly decided that Respondent Lindeburg's sale of merchandise bearing Petitioner's name or emblem does not give rise to a likelihood of confusion or origin or sponsorship—the proper test to be applied in all trademark cases. It is submitted that this type of analysis does not merit Supreme Court

review, particularly in view of the Ninth Circuit's definitive examination and adoption of the trial court's Findings in this case:

> "We conclude from our examination of the trial judge's findings and of the underlying evidence that Lindeburg was not using the Job's Daughters name and emblem as trademarks. The insignia were a prominent feature of each item as to be visible to others when worn, allowing the wearer to publicly express her allegiance to the organization. Lindeburg never designated the merchandise as 'official' Job's Daughters' merchandise or otherwise affirmatively indicated sponsorship. Job's Daughters did not show a single instance in which a customer was misled about the origin, sponsorship, or endorsement of Lindeburg's jewelry, not that it received any complaints about Lindeburg's wares. Finally, there was evidence that many other jewelers sold unlicensed Job's Daughters jewelry, implying that customers did not ordinarily purchase their fraternal jewelry from only 'official' sources." (Opinion, p. 12)

V

CONCLUSION

This case does not merit Supreme Court review because it represents merely the application of established trademark principles to the peculiar facts of this case. Any contention that a conflict exists between the Circuits as to the legal principles to be applied to the facts of this case is an illusion—there is no conflict in the law to be applied.

The Circuits have reached different results in different cases because the facts, and not the applicable law, were different.

Dated: May 26, 1981

Respectfully submitted,

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